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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,590	10/19/2001	Mark DeSilets	US018173	1157

7590

01/13/2004

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EXAMINER

LIN, JEYUHU

ART UNIT	PAPER NUMBER
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3737

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,590

Applicant(s)

DESILETS ET AL.

Examiner

Jeoyuh Lin

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7-17,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 11-16 is/are allowed.
- 6) ☒ Claim(s) 3, 4, 7-9, 17, 20, and 21 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Entry of Amendment

1. Applicant's amendment, filed on October 10, 2003, as paper No. 11, is acknowledged. Claims 1, 3, 4, 7-17, 20, and 21 are currently pending.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/027,843. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims comprise:

- A first tomographic medical imaging device having a first bore,
- A second tomographic medical imaging device having a second bore, and
- The first and second imaging devices, each secured by a housing.

Claim 1 of the '843 has a narrower scope in that it further comprises, "an actuating mechanism for moving the first and second imaging devices. However, since the other elements between the claims are identical, should both applications become allowed, claim 1 of the '843 application would be readable on the more general claim 1 of the instant application. Therefore, provisional double-patenting exists.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

-Claims 3, 4, 7, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by McKinnon. (US 6,591,127 B1)

McKinnon teaches a medical imaging apparatus, comprising:

-A first imaging device for obtaining one or more tomographic images of a subject patient, wherein at least a portion of the first imaging device has a bore through which a patient axially translates during formation of one or more images by the

device (Figure 1, element 20, having bores 22 and 24, and also column 3, lines 5-19).

-A second imaging device for obtaining one or more tomographic images of the subject patient, wherein at least a portion of the second imaging device has a bore through which a patient axially translates during formation of the images by the device (Figure 1, system 18, and column 3, lines 20-32, wherein the c-arm forms a bore there-through which the patient is axially translated.)

-Alignment structure securing the openings of the first and second imaging devices in alignment with an imaging axis during the formation of one or more tomographic images, by at least one of the imaging devices, of the subject patient;

-A patient support structure extending through the openings of the first and second imaging devices during the formation of one or more images by at least one of the imaging devices; and

-An actuator for separating the first and second openings of the first and second imaging devices from each other by a selected distance, (Column 3, lines 20-31), wherein the distance between the first and second openings allows a caregiver to perform one or more interventional applications on the subject patient between the first and second imaging devices and the distance is sufficient to allow a caregiver to perform at least a portion of a biopsy procedure on the subject patient. (Column 7, lines 9-54)

-Claims 3, 7, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Townsend et al. (US 6,490,476 B1)

Townsend teaches a combined PET and X-ray CT imager, comprising:

- A first CT tomographic imager with a first opening, as in claim 7. (Column 12, line 49)
- A second PET tomographic medical imager having a second opening, as in claim 8. (Column 12, lines 50) (Figure 2b)
- Alignment structure securing the openings of the first and second imaging devices in alignment with an imaging axis during the formation of one or more tomographic images, by at least one of the imaging devices, of the subject patient; (Column 12, lines 49-53)
- A patient support structure extending through the openings of the first and second imaging devices during the formation of one or more images by at least one of the imaging devices; (Space provided between CT and PET imagers, figure 2B) and
- An actuator for separating the first and second openings of the first and second imaging devices from each other by a selected distance, wherein the distance between the first and second openings allows a caregiver to perform one or more interventional applications on the subject patient between the first and second imaging devices and the distance is sufficient to allows a caregiver to perform at least a portion of a biopsy procedure on the subject patient. (Column 20, lines 3-10)

-Claims 17, 20, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Ivan et al. (US 6,364,536 B2).

Ivan teaches an MR/X-Ray imager, comprising:

- Providing a first housing supporting a first tomographic scanner having a first bore for obtaining tomographic imaging information from at least a portion of a patient;
- Providing a second housing supporting a second tomographic scanner having a bore for obtaining tomographic imaging information from at least a portion of a patient; (Column 10, lines 46-55)
- Connecting the first and second housings by an actuator,
- Actuating the actuator to position each of the first and second housings between an adjoined position, with the axes of the first and second scanner bores substantially aligned, and a separated position, with the scanner bores spaced from each other by the linear actuator; (Column 10, lines 35-55)
- Operating the first and second scanners in different modalities with respect to each other when the first and second scanners are in the adjoining position to obtain imaging information from the patient; and
- Operating one of the first and second scanners in a modality obtaining imaging information representing anatomical structures of the patient when in the first and second scanners are in the separated position. (Column 10, lines 35-40)
- Further comprising forming a patient access area between the first and second scanners bores when the first and second housings are placed in the adjoining

position, the access area allowing direct access by a caregiver to a patient extending through the first scanner bore and at least partially positioned between the first and second scanners, as in claim 20. (Figures 2 and 8)

-Further comprising operating one of the first and second scanners in a modality obtaining imaging information representing physiologic functions of the patient, which are inherently obtained when one obtains a diagnostic scan image, (Column 4, line 50) as in claim 21.

Allowable Subject Matter

4. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. Claims 1 and 11-16 are allowed.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 3, 4, 7-17, 20, and 21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeoyuh Lin whose telephone number is (703) 306-5990. The examiner can normally be reached on m-f, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Ruhl can be reached on (703) 308-2262. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-0758.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

JYL

JYL
January 10, 2004


DENNIS W. RUHL
SUPERVISORY PATENT EXAMINER